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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/399,083	09/17/1999	DAVID CALDERWOOD	BBIC-043/A	1842

7590 09/09/2005

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EXAMINER

RAO, DEEPAK R

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HC

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/399,083	Applicant(s) CALDERWOOD ET AL.	
	Examiner Deepak Rao	Art Unit 1624	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 22 July 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

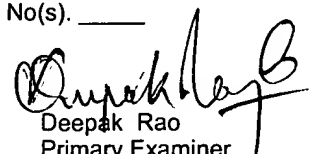
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 52.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-8, 10, 46 and 47.
 Claim(s) withdrawn from consideration: 11 and 48-51.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


 Deepak Rao
 Primary Examiner
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ADVISORY ACTION

The amendment filed August 22, 2005 under 37 CFR 1.116 in reply to the advisory action has been acknowledged. While the amendment complies with the requirements of 37 CFR 1.121(c), is not deemed sufficient to overcome the rejections of record. Applicant's arguments filed on July 22, 2005 have been fully addressed in the previous office action, which are provided below for convenience.

The amendment in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

The proposed amendments and applicant's arguments are not deemed to be sufficient to overcome the rejection of claims 1-8, 10, 46 and 47 under 35 U.S.C. 103(a) as being unpatentable over Calderwood et al., WO 98/41525, for the reasons provided in the previous office action.

Applicant cites *In re Baird* and argues that the genus of the reference is not sufficient to establish a *prima facie* case of obviousness for the instantly claimed genus or species. However, it was clearly established in the previous office action that the reference teaches a generic group of compounds that are useful as pharmaceutical therapeutic agents and further discloses several species falling within that genus. Further, it was discussed that a compound of the instant claims differs from the reference disclosed compound only by a substituent, which substituent falls within the group of substituents that have been taught to be equivalents in the reference. Applicant's arguments based on *In re Baird* are fully considered but they were not found to be persuasive because the decision in *Baird* was based on a very large genus encompassing millions of compounds vs. a small number of claimed species, "[A] disclosure of millions of compounds

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does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.” 29 USPQ2d 1552. While the instant case involves a genus, the reference also discloses several compounds that are structurally analogous to the reference compounds, of which one compound was readily compared to applicant's claimed compound, and it was established that the claimed compounds are structurally analogous to the reference compounds (see the discussion in the previous office action). Thus, the reference teaches structurally analogous compounds which are disclosed to be useful as therapeutic agents. Therefore, motivation exists to prepare other structurally analogous compounds from the prior art disclosed genus. Such structural analogs of the reference compounds would have been obvious to one of ordinary skill in the art because the skilled chemist would have had the reasonable expectation of obtaining compounds having similar properties, i.e., pharmaceutical therapeutic agents. Reference must be considered, under 35 U.S.C. 103, not only for what it expressly teaches but also for what it fairly suggests; all disclosures of prior art, including unpreferred embodiments, must be considered in determining obviousness. *In re Burckel*, 201 USPQ 67 (CCPA 1979).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Acting-SPE of 1624, can be reached at (571) 272-0661. The fax

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phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

September 7, 2005